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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,945

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EXAMINER

NICKERSON, JEFFREY L

ART UNIT

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2142

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/521,945	<b>Applicant(s)</b> HASEGAWA, TADASHI	
	<b>Examiner</b> JEFFREY NICKERSON	<b>Art Unit</b> 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-4 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 7-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>31 October 2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This communication is in response to Application No. 10/521,945 filed nationally on 21 January 2005 and internationally on 22 July 2002. The amendment presented on 02 April 2008, which cancels claims 1, 5, and 6, provides change to the specification and claims 2-4 and 7, and adds claims 8-9, is hereby acknowledged. Claims 2-4, and 7-9 have been examined.

#### ***Specification***

2. The amendment presented on 02 April 2008 providing change to the specification is noted. All prior objections to the specification are hereby withdrawn.

#### ***Claim Objections***

3. The amendment presented on 02 April 2008 providing change to the claims to fix grammatical and antecedent basis issues is noted. All prior objections to the claims are hereby withdrawn.

#### ***Claim Rejections - 35 USC § 112***

4. The amendment presented on 02 April 2008 providing change to the claims is noted. All prior rejections to the claims under 35 USC 112 are hereby withdrawn.

***Response to Arguments***

5. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., parsing for variations of domain and site names) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

6. Applicant's arguments filed 02 April 2008 have been fully considered but they are not persuasive.

Applicant traverses the rejection of claim 2 as being anticipated by Riemers (US 6,615,242 B1) because the following limitation is allegedly not taught by Riemers:

**an unsolicited bulk electronic mail decision portion deciding whether or not the received second electronic mail is unsolicited depending on whether the second URL contains the first domain name and the first site name.**

The examiner respectfully disagrees. The Riemers reference discloses identifying URLs in electronic messages, fetching the content designated by the URL, fetching all further content with embedded URLs, analyzing the fetched content, assigning a score to the fetched content, and determining if the message is spam using the scoring mechanism (Riemers: col 4, line 66 – col 5, line 19 for overview of fetching and

Art Unit: 2142

analyzing; col 3, lines 56-66 describes scoring). Riemers further discloses that this fetched content and score can be cached locally, so that when receiving subsequent emails (received second email) with the same URL (where the second URL contains the first domain name and first site name), a determination can be made on whether the message is spam (unsolicited bulk electronic mail) without fetching the content from a remote site again (Riemers: col 3, lines 40-55). In order to perform this, Riemers must inherently be comparing the prior stored URL with the second newly received URL, where the URLs consist of a domain and a site (Riemers: col 3, lines 18-39), and therefore Riemers is deciding whether or not the received second electronic mail is unsolicited depending on whether the second URL contains the first domain name and the first site name. Therefore, the rejection is hereby maintained.

Applicant traverses the rejections of claims 3-4 and 7 conditionally based on claim 2.

Therefore, these rejections are hereby maintained for reasons stated above.

### ***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 2-4, 7, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Riemers (US 6,615,242 B1).

Regarding claim 2, Riemers teaches an electronic mail server for relaying electronic mail to be sent from a first terminal device of an electronic mail sender to a second terminal device of an electronic mail receiver (Riemers: Figure 1), comprising:

- a URL rule storage portion (Riemers: Figure 1, item 109; memory) storing URL rule information (Riemers: Figure 1, item 112; URLs/scores) that indicates a relationship between a domain name of a domain and a site name of a Web site that is provided to the domain (Riemers: col 3, lines 18-39 specify that the information obtained from the URL include the domain and the files hosted, which together form a website, and provide that information can be gathered according to the site or the domain);

- a first reception portion (port) receiving unsolicited bulk electronic mail from the second terminal device of when the first electronic mail containing the first URL is decided to be unsolicited by the electronic mail receiver (Riemers: Figure 1, item 104 into item 107; Riemers: col 1, lines 15-35 specify the recipient identifying the spam and passing it on);

- a domain extraction portion extracting a first domain name from the first URL (Riemers: col 3, lines 18-39 specify identifying the domain; See also col 4, line 66 – col 5, line 19);

- a Web site specifying portion specifying a first Web site that delivers a first Web page indicated in the first URL by referring to the URL rule information based on the extracted first domain name (Riemers: col 3, lines 18-39 specify identifying the web site in accordance with the domain; See also col 4, line 66 – col 5, line 19);

an unsolicited site storage portion storing the extracted first domain name and a first site name of the first Web site as unsolicited site information in connection with the electronic mail receiver (Riemers: col 3, lines 40-55 specify storing the URL information in a database; col 3, lines 25-32 specify the URL information is domain and site information);

a second reception portion receiving second electronic mail containing a second URL from the first terminal device (Riemers: col 1, line 63 – col 2, line 7; See also col 2, lines 23-42);

an unsolicited bulk electronic mail decision portion deciding whether or not the received second electronic mail is unsolicited depending on whether or not the second URL contains the first domain name and the first site name (Riemers: col 4, lines 1-13 specify looking up stored URL information gathered from previous messages based off the URL; col 3, lines 40-55 specify looking up URL information from the database once it has been cached; col 3, lines 25-39 provide the domain and site information is part of the URL);

a transmission portion transmitting the second electronic mail to the second terminal device only when the second electronic mail is decided not unsolicited by the unsolicited bulk electronic mail portion (Riemers: col 5, lines 19-35 specify the email is forwarded if it isn't spam).

Regarding claim 3, Riemers teaches an electronic email server further comprising:

a first Web page obtaining portion obtaining the first Web page indicated in the first URL contained in the first electronic mail received by the first reception portion (Riemers: col 3, lines 25-55 specify that the URL site information can be fetched); and wherein:

if the first Web page obtained by the first Web page obtaining portion contains a code for jumping to a second Web page automatically (Riemers: col 4, line 66 – col 5, line 19 specify identifying a second URL in the first site and performing content analysis of the second URL and then repeating as necessary),

the domain extraction portion extracts a second domain name of a second domain in which the second Web page is provided (Riemers: col 3, lines 25-39 specify identifying the domain; col 4, line 66 – col 5, line 19 specify the same analysis is performed for each embedded URL);

the Web site specifying portion specifies a second Web site that delivers the second Web page (Riemers: col 3, lines 25-39 specify identifying the web site; col 4, line 66 – col 5, line 19 specify the same analysis is performed for each embedded URL); and

the unsolicited site storage portion stores the second domain name of the second domain and a second site name of the second Web site as unsolicited site information (Riemers: col 3, lines 40-55 specify storing the URL information in a database; col 4, line 66 – col 5, line 19 specify the same analysis is performed for each embedded URL).

Regarding claim 4, Riemers teaches an electronic mail server further comprising:



a second Web page obtaining portion obtaining a second Web page indicated in the second URL contained in the second electronic mail received by the second reception portion (Riemers: col 4, line 66 – col 5, line 19), wherein

if the second Web page obtained by the second Web page obtaining portion contains code for jumping to a third Web page automatically, the unsolicited electronic mail decision portion decides whether or not the second electronic mail is unsolicited depending on whether a third URL of the third Web page contains the first domain and the first site name (Riemers: col 4, line 66 – col 5, line 19 specify the same analysis is performed for each embedded URL; See also col 3, lines 40-55, which specify URLs can be determined as unsolicited based on cached versions of previously fetched URLs, thereby depending on whether the new URL contains the previous domain and site).

Regarding claim 7, this server claim contains limitations found within claim 4 and the same rationale of rejection is used, where applicable.

Regarding claim 9, this computer program product claim contains limitations corresponding to claim 2 and the same rationale of rejection is used, where applicable.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2142

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Riemers (US 6,615,242 B1), and further in view of Basko et al (US 7,117,193 B1).

Regarding claim 8, this method claim comprises limitations corresponding to claim 2 and the same rationale of rejection is used, where applicable.

Though Riemers does teach sending the received electronic mail to a terminal device of a destination address of the received electronic mail only when it is decided that that the received electronic mail does not contain a whole of the URL (Riemers: col 5, lines 19-35 specify filtering based on a score; col 3, lines 40-67 specify looking up scores based on stored URLs), Riemers does not teach matching parts of URLs to the stored URLs.

Basko, in a similar field of endeavor, teaches matching parts of a URL against stored URL patterns (Basko: col 27, line 29 – col 30, line 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the teachings of Basko for matching parts of a URL. The teachings of Basko, when implemented in the Riemers system, will allow one of ordinary skill in the art to keep track of URL scores using URL patterns and wildcards. One of ordinary skill in the art would be motivated to utilize the teachings of Basko in the

Riemers system in order to prevent sneaky solicitors from slyly circumventing stored standard-form URL string series.

***Cited Pertinent Prior Art***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Bellinson et al (US 2004/0006621 A1) discloses matching URLs based on variable characteristics of the URLs.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY NICKERSON whose telephone number is (571)270-3631. The examiner can normally be reached on M-Th, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. N./  
Jeffrey Nickerson  
Examiner, Art Unit 2142

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